

REMARKS/ARGUMENTS

In response to the Office Action dated January 5, 2004, claim 15 is amended to correct a minor clerical error and not to change the scope thereof. Claims 1-22 are now active in this application. No new matter has been added.

OBJECTION TO THE SPECIFICATION

The Examiner objects to incorporation by reference of the foreign application denoted at page 1, lines 4-6 of the present application. However, Applicants maintain that the present incorporation by reference is proper and achieves a proper purpose.

The foreign application that has been incorporated by reference is the Priority Document of the present application that was translated from Japanese to English in order to file the present application. Consequently, the material incorporated by reference *is the subject matter presently disclosed in the present application* and is not subject to the prohibition noted in the present Office Action, as the present disclosure is the very information that the Examiner contends needs to be included in the present disclosure. Certainly, the Examiner cannot be requiring that the information already in the present application be repeated, as this would be the net result of including the material incorporated by reference.

In this regard, the Examiner should understand that by incorporating the foreign language Priority Document by reference, Applicants are attempting to guard against undetected and an inadvertent *translation error*, the correction of which, during prosecution, could be barred as being new matter. Specifically, if during the course of prosecuting the present application, a translation error is detected where material in the original foreign language Priority Document is

found to be necessary to support the claims or to provide adequate disclosure of the invention pursuant to 35 U.S.C. § 112, the present incorporation by reference will allow Applicants to amend the disclosure to include the material incorporated by reference without running afoul of the prohibition against adding new matter in 35 U.S.C. § 132. Should such a circumstance occur, Applicants would accompany any amendment by a supporting affidavit or declaration stating that the amending material consists of the same material that is in the Priority Document that is incorporated by reference.

This approach is completely in accordance with *In re Hawkins*, 179 USPQ 157 (C.C.P.A. 1973). There, the Court of Customs and Patent Appeals held that where a foreign application (British) had been incorporated by reference in a U.S. application, the amendment of the U.S. application during prosecution to expressly include the material from the British application is *not* new matter. 179 USPQ 162 (emphasis in original). Additionally, the CCPA held that the final determination of the adequacy of the specification as to whether it is enabling is measured at the issue date, not the filing date. Thus, if an originally submitted specification is not sufficient by itself to enable one skilled in the art to make and use the invention, the specification may be amended during prosecution--within the boundary set by 35 U.S.C. §132--to make it enabling. 179 USPQ 162.

In the present case, Applicants do not believe that the foreign-language Priority Document contains any (essential) material which is not already described in the present application since, as noted above, the foreign application Priority Document was translated from Japanese to English in order to file the present U.S. application. However, by incorporating the foreign application Priority Document by reference, Applicants have preserved the opportunity

to amend the present specification, during prosecution, in accordance with this material without incurring a new matter rejection should such an amendment be found necessary.

Furthermore, “essential material” is defined at M.P.E.P. § 609.01(p)(I)(A) as that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode. It is “essential material” that an application which is to issue as a U.S. patent **may not** incorporate by reference to (1) patents or applications published by foreign countries or a regional patent office, (2) non-patent publications, (3) a U.S. patent or application which itself incorporates “essential material” by reference, or (4) a foreign application.

It is quite clear that the Examiner objects to the incorporation of the foreign Priority Document, as is done at page 1, lines 4-6, ***based upon form used and without regard to substance***. In this regard, the Examiner must appreciate that the present application itself is complete, fully complying with 35 U.S.C. § 112. Furthermore, Applicants are **NOT** aware of any subject matter in the foreign applications referred to at page 1, lines 4-6 (the foreign Priority Document) that is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode (i.e., “essential material”) **that is not already completely described in the present application**. However, if the Examiner determines that there is specific subject matter in the foreign applications referred to at page 1, lines 4-6 (the foreign Priority Document) that is not already described in the present application and which is necessary for the present application to fully comply with 35 U.S.C. § 112, and the Examiner identifies that specific subject matter, Applicants will provide the appropriate amendment and declaration.

In view of the foregoing, withdrawal of the objection to incorporation by reference of the foreign Priority Document is respectfully solicited.

REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103

I. Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by Stephenson (USPN 5,757,388).

Claims 2 and 3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephenson in view of Amoni (USPN 5,884,086).

Claims 4-7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephenson in view of Amoni and Yokoyama (USPN 5,694,226).

Claims 8, 9 and 11-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephenson in view of Yokoyama.

Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephenson in view of Yokoyama and Kawai (USPN 5,805,780).

Claim 14 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephenson in view of Yokoyama and further in view of *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) and Yokoyama (USPN 5,694,226).

Claims 15 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephenson in view of Amoni and Kawai.

Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephenson in view of Amoni, Kawai and Meese (USPN 4,532,418) and further in view of *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephenson in view of Amoni and Kawai and further in view of *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

Claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephenson in view of Amoni, Kawai and Meese, and further in view of *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965).

Claims 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Stephenson in view of Amoni, Kawai and Meese.

II. The rejections are respectfully traversed.

Independent claims 1, 2, 8 and 11 include a “detecting unit” for detecting whether an external device has been connected to an image forming apparatus. In contrast, latch driver 26 of Stephenson (U.S. Patent No. 5,757,388) is merely an actuator (e.g. solenoid) controlled by printer electronics 30 (see column 2, lines 60-64; column 4, lines 13-21), and does not have a detection function for *detecting* whether or not a camera is mounted on a printer.

Anticipation, under 35 U.S.C. § 102, requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983).

Thus, a detecting unit, required in claim 1, is not found in Stephenson, either expressly described or under principles of inherency. Consequently, claim 1 is patentable over Stephenson and its allowance is respectfully solicited.

Furthermore, Stephenson neither discloses nor suggests the detecting units recited in claims 2, 8 and 11. Consequently, the Examiner did not establish a *prima facie* basis to deny

patentability to the inventions of claims 2, 8 and 11 for want of the requisite factual basis; i.e., the claimed invention does not result even when Stephenson is considered alone or in view of Amoni or Yokoyama, which also fail to disclose a detecting unit.

Therefore, the allowance of independent claims 2, 8 and 11 as well as dependent claims 3-7, 9 and 10, is respectfully solicited.

The invention recited in independent claim 20 includes a “charge collecting unit” for collecting *a charge for an amount of power that has been supplied to the external device*. The Examiner cites Kawai (U.S. Patent No. 5.805.780) in regard to this point. Kawai, which relates to an “automatic photographing box”, discloses only that, “a numeral 8 denotes a money handling machine” (see column 5, lines 54-55), without providing any further specific details.

Consequently, Kawai cannot reasonably be interpreted as disclosing charge collecting unit for collecting *a charge for an amount of power that has been supplied to the external device*, nor provide any disclosure that would allow an artisan to readily infer such feature. Independent claims 15 and 21 have similar features as independent claim 20.

Thus, independent claims 15, 20 and 21 are patentable over Stephenson, considered alone or in combination with Amoni, Kawai and Meese. Therefore, the allowance of independent claims 15, 20 and 21, as well as dependent claims 16-19 and 22, is respectfully solicited.

CONCLUSION

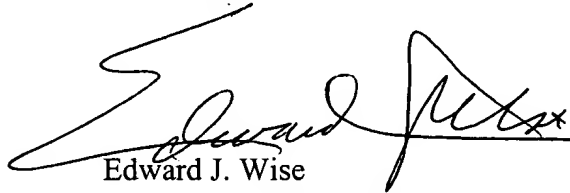
Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

09/585,339

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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